

REMARKS

This Amendment is in response to the Office Action mailed on September 26, 2002. In that Office Action, claims 29-40 are rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claims subject matter surrendered in the application for the patent upon which the present reissue is based. Claims 29-40 were rejected under 35 U.S.C. § 102 (b) as being clearly anticipated by Weiss, U.S. Patent #4,828,186. Claims 1-28 were allowed.

The Examiner also stated that the application is defective because it fails to contain a statement that all errors, which are being corrected in the reissue application up to the time of filing of the Oath/Declaration, arose without any deceptive intent on the part of the Applicant. A Supplemental Declaration containing the exact phrase will be provided once claims 29-40 have been allowed. Additionally, a substantially similar statement was included in paragraph 7 of the Declaration signed by Mr. Poll on February 14, 2002 and submitted to the U.S. Patent and Trademark Office on February 20, 2002.

35 U.S.C. § 251 REJECTIONS

Claims 29-40 are rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject surrendered in the application for the patent upon which the present reissue is based. Applicant respectfully disagrees as there was no subject matter surrendered to distinguish over prior art of record that applicant is now attempting to recapture.

The Examiner cites *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 U.S.P.Q.2d 1641 (Fed. Cir. 1998) for the pronouncement of the standard for determining recapture. "To determine whether an applicant surrendered particular subject matter, we look to the prosecution history arguments and changes to the claims made in an effort to **overcome a prior art rejection**. (Emphasis added). *Id. at 1480*. See also, *Mentor Corp. v. Coloplast, Inc.* 998 F.2d at 995-996, 27 U.S.P.Q.2d at 1524-25 (Fed. Cir. 1993); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 U.S.P.Q. 289, 294-95 (Fed. Cir. 1984).

Claims 29, 34, 37, 39 and 40 are amended to each include "v-shape" to reflect the language of claim 18 and to overcome the Examiner's rejection. The support for the addition is shown in Figures 2, 3 and 4. Claims 30-33, 35-36 and 38 are dependant off of claims 29, 34, and 37. Therefore they should also overcome the Examiner's rejection with the amendment of their respective independent claims.

With this response, the rejection of claims 29-40 have been overcome. The application is now in condition for allowance, and notice to that effect is respectfully requested.

35 U.S.C. §102(b) REJECTIONS

Claims 29-40 are rejected under U.S.C. §102(b) as being anticipated by Weiss. In order to be a §102(b) reference, the reference must teach each and every limitation of the claims. Weiss does not teach each and every limitation of the claimed invention. The Weiss patent claims and teaches a device in which a rotatably mounted support is attached to a trailer beneath the boat. The Weiss device is a boat motor support to be utilized in towing a boat on a trailer and cannot be used in water. The device is comprised of a frame and motor mount brackets with adjustable telescoping arms used with cushion elements to absorb impact loads from the overhanging motor. Weiss' invention supports the boat motor with respect to the trailer. The invention of claims 29, 34, 37, 39 and 40 pivotally connects to the boat on one end at a position above the bottom edge of the transom, while the other engages and supports the motor, allowing the motor support to be used in water.

Claim 29 requires "a v-shape support rotatably mounted with respect to the motor in a position above a bottom edge of the transom". Weiss does not contain that limitation. The device in the Weiss patent has a linear support that is mounted on a boat trailer beneath the transom of the boat.

Claim 34 requires "a v-shape support having a cradle at a second end and having a first end rotatably mounted about a horizontal pivot axis which is generally parallel to the transom and located above a bottom edge of the transom". Weiss does not contain that limitation. The

device in the Weiss patent has a linear support that is mounted underneath the transom of the boat on a boat trailer.

Claim 37 requires "a v-shape support having a cradle at a first end, wherein a second end of the support is mounted for pivotal movement about an axis located above a bottom edge of the transom". Weiss does not contain that limitation. The device in the Weiss patent has a linear support in which the second end is located below the transom of the boat on the boat trailer.

Claim 39 requires "a v-shape support rotatably mounted at a first end and having a cradle at a second end, the support being rotatable about a pivotal axis located above a bottom edge of the transom". Weiss does not contain that limitation. The device in the Weiss patent has a linear support which is connected underneath the bottom edge of the transom.

Claim 40 requires "a v-shape support rotatably mounted at a first end and having a cradle at a second end, the support being rotatable about a pivotal axis located above a bottom edge of the transom". Weiss does not contain that limitation. The device in the Weiss patent has a linear support that is mounted underneath the transom of the boat on a boat trailer.

The invention of claims 29, 34, 37, 39 and 40 is connected to the transom on one end and the motor on the other end. It is not connected to a boat trailer underneath a boat. The Weiss device is connected to a boat trailer below the transom of the boat on one end and the motor on the other. The first connect in claims 29, 34, 37, 39, and 40 (the transom of a boat) are different from the first connection in the Weiss patent (the trailer under the transom of the boat). The first connection in the Weiss patent is not on the boat at all, while the entire device in claims 29, 34, 37, 39 and 40 is connected above the bottom edge of the transom of the boat.

The Weiss patent, as interpreted by the Examiner, includes tie down brackets 20, 24 and 28. However, elements 20 and 24 are actually the support arm which extends from the boat trailer 18 and comprises the first and second members, respectively which are telescoping in relation to the other. Further, element 28 is a pair of eyelets that are located at the end of bracket 20 and proximate to cradle 22. Weiss teaches a support that is connected to a trailer and a motor to be used for transport of the motor on land. Contrary to Weiss, claims 29, 34, 37, 39 and 40 teach a support

that is connected between the boat and motor to be used when the boat is in the water. Thus, Weiss does not teach each and every limitation of the claimed invention of claims 29, 34, 37, 39 and 40. As such, claims 29, 34, 37, 39 and 40 are not anticipated by Weiss.

Claims 30-33, 35-36 and 38 were also rejected under 35 U.S.C. §102(b) as being clearly anticipated by Weiss. Claims 30-33 depend from claim 29, claims 35-36 depend from claim 34, and claim 38 depend from claim 37. As previously set forth, claims 29, 34, 37, 39 and 40 are not anticipated or otherwise taught by Weiss. Weiss does not teach the use of a support connected to the boat to be utilized in water. As such, Weiss does not suggest or teach every limitation of the claimed invention. Thus, claims 30-33, 35-36 and 38 are not shown, suggested or taught by Weiss. Applicant has presented claims that are believed to be in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,

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**APPENDIX:
MARKED UP VERSION OF SPECIFICATION AND CLAIM AMENDMENTS**

29. (Amended) An outboard motor support device for securing an outboard motor to a transom of a boat, the device comprising:

- a tie down bracket;
- a v-shape support rotatably mounted with respect to the motor at a position above a bottom edge of the transom such that when the motor is in an up position the support can rotate about its mounting point to contact and support the motor and when the motor is in a down position the support is positioned between the motor and the transom; and
- a tie down element which passes behind the motor and is secured to the tie down bracket when the motor is in the up position to hold the motor in contact with the support.

34. (Amended) An outboard motor support device for securing an outboard motor to a transom of a boat, the device comprising:

- a rigid tie down member;
- a v-shape support having a cradle at a [first] second end and having a [second] first end rotatably mounted about a horizontal pivot axis which is generally parallel to the transom and located above a bottom edge of the transom such that when the motor is in an up position the support can rotate about the pivot axis to contact and support the motor in the cradle and when the motor is in a down position the support is positioned between the motor and the transom; and
- a flexible tie down element connectable to opposite ends of the tie down member which passes behind the motor to hold the motor in contact with the cradle when the motor is in its up position.

37. (Amended) An outboard motor support device for securing an outboard motor to a transom of a boat, the device comprising:

- a tie down bracket having holes at opposite ends;
- a v-shape support having a cradle at an a first end, wherein a second end of the support is mounted for pivotal movement about an axis located above a bottom edge of the transom such that when the motor is in an up position the support can rotate about its mounting point to a first position at which the cradle receives and supports the motor along a drive shaft housing of the motor and when the motor is in a down position the support is in second position between the motor and the transom; and

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Application No.: 09/803,453

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a tie down element having a pair of hooks secured to its ends, wherein each one of the hooks is secured in one of the holes in the tie down bracket and the tie down element passes behind the drive shaft housing of the motor to hold the drive shaft housing in contact with the cradle when the motor is in the up position.

39. (Amended) An outboard motor support device for securing an outboard motor to a transom of a boat, the device comprising:

a rigid tie down member;

a v-shape support rotatably mounted at a first end and having a cradle at a second end, the support being rotatable about a pivotal axis located above a bottom edge of the transom so that when the motor is in an up position the support can rotate about its first end so that the cradle receives and supports the motor along a drive shaft housing of the motor and when the motor is in a down position the support is positioned between the motor and the transom;

a flexible tie down element connectable to the rigid tie down member, which passes behind the motor for securing the drive shaft housing in place against the cradle when the motor is in an up position.

40. (Amended) An outboard motor support device for securing an outboard motor to a transom of a boat, the device comprising:

a rigid tie down member;

a v-shape support rotatably mounted at a first end and having a cradle at a second end, the support being rotatable about a pivotal axis located above a bottom edge of the transom so that when the motor is in an up position the support can rotate about its first end so that the cradle receives and supports the motor along a drive shaft housing of the motor and when the motor is in a down position the support is positioned between the motor and the transom;

a flexible tie down element connectable to the rigid tie down member, which passes behind the motor for securing the drive shaft housing in place against the cradle when the motor is in an up position; and

means connected between the support and the motor for rotating the support upward when the motor is tilted from the down position to the up position.

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